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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-------------------------|-------------|----------------------|---------------------|------------------|
| 09/935,393 | 08/23/2001 | William Kress Bodin | AUS920010655US1 | 9825 |
| 45993 | 7590 | 11/20/2007 | EXAMINER | |
| IBM CORPORATION (RHF) | | | CASLER, TRACI | |
| C/O ROBERT H. FRANTZ | | | ART UNIT | PAPER NUMBER |
| P. O. BOX 23324 | | | 3629 | |
| OKLAHOMA CITY, OK 73123 | | | | |
| MAIL DATE | | DELIVERY MODE | | |
| 11/20/2007 | | PAPER | | |

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/935,393
Filing Date: August 23, 2001
Appellant(s): BODIN, WILLIAM KRESS

MAILED

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GROUP 3600

Robert H. Frantz
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed July 13, 2007 appealing from the Office action mailed April 18, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

Claims 1 and 21 have been amended subsequent to the final rejection.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

The amendment after final rejection filed on July 17, 2007 has been entered.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

20010028301 Geiger et al 10-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1-5, 10-15, 20-25 and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent Publication 20010028301 Geiger et al. Electronic Shopping Cart Display System. Hereinafter referred to as Geiger.

2. As to claims 1, 11 and 21 Geiger teaches:

Identifying a consumer **when the shopper pushing the cart most into a transceiver location** the consumer identification unit is mounted on the cart which is “near” the display. (Pg.4 Pg. 48-49 Pg. 6 ¶ 73).

Retrieving preferences of consumer(Pg. 6 ¶ 73 Pg 8 105).

Matching products with preferences(Pg. 1 ¶ 9; Pg. 5 ¶ 58).

Activating a display unit “near” a retail fixture, the display unit directs the users attention to the location(Pg. 1 ¶9 Pg. 7 ¶ 92). *the transceivers also function to flash lights to direct consumer attention).**

3. As to claims 2, 12 and 22 Geiger teaches the identifying with a magnetic strip card.(Pg. 6 ¶ 73).
4. As to claims 3, 13 and 23 Geiger teaches accessing a database.(Pg 8 ¶95)
5. As to claims 4, 14 and 24 Geiger teaches matching price(Pg. 5 ¶58).
6. As to claims 5, 15 and 25 Geiger teaches indicator as light, text etc(Pg. 1 ¶ 9).
7. As to claims 10, 20 and 20 Geiger teaches the database maintaining inventory information.(Pg. 4 ¶ 48 & Pg. 8 ¶ 99).

Claim Rejections - 35 USC § 103

8. Claims 6-9, 16-19 and 26-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over. US Patent Publication 20010028301 Geiger et al. Electronic Shopping Cart Display System. Hereinafter referred to as Geiger.
9. As to claims 6-9, 16-19 and 26-29 Geiger teaches an intelligent merchandise indicator in which the system is further used as an advertising/promotion system for direct marketing to consumers. However, Geiger fails to teach sending product reference information to consumer via email message. It would have been obvious to combine Geiger's direct marketing system with an email system for emailing the information to the consumers as online advertising is a commonly used form of direct marketing campaigns.

(10) Response to Argument

Rejection of Independent Claims 1, 11 and 21 as being anticipated by Geiger

The appellant argues that the examiner has not properly read the claims "in light of the specification". The appellant identifies the limitation of "mounted on or near" as being improperly interpreted. The appellant argues that this limitation should be interpreted as "mounted on or mounted near" rather than "mounted on or being near". The examiner notes that regardless of how the appellant intends the limitation to be read the examiner is still required to give the broadest reasonable interpretation. The claims could be interpreted as "mounted on or being near". The examiner notes that as appellants specification teaches the units as mounted on or near display through out the specification, such as ¶ 28 and ¶ 29 in which appellant argues the consumer ID unit can be "mounted on the front or underneath the surface of the display fixtures itself, or alternatively in a nearby fixture or even in the ceiling above the fixture. Therefore, if the consumer ID is mounted on a shopping cart as taught in Geiger, this falls within in the light of the specification as disclosed by the appellant. The examiner notes the appellants arguments are directed towards a limitation that is narrower than the actual claim language. If appellant intends the claim language to be read as mounted on or mounted near the claims need to read as such so as to limit how broadly a claim limitation can be interpreted.

On Pg. 7 of the Brief the appellant begins to argue that Geiger fails to teach "mounted on a retail display fixture" but instead teaches mounted on a shopping cart." The examiner first notes as appellants claim construction is in the alternative the limitation of being mounted on a retail display fixture is not required as Geiger teaches the identifier as being mounted on a shopping cart which is near the display." The appellant argues that the examiner fails to cite where in appellants specification the examiner finds support for the broadening of the claim interpretation. The examiner is unaware of any requirement to point out how the appellant's disclosure supports the examiners interpretation of the claims. However, for the sake of prosecution the examiner notes that the above noted paragraphs(28-29) support the examiner interpreting the claims in a broader manner than that intended by the appellant. Appellants disclosure teaches the mounts on the ceiling of a stores as well a near by fixture, therefore, the mounting on a shopping cart in a nearby fixture and in some cases closer than a store ceiling to a display fixture.

Appellant argues that the law does not require negative claiming to define their invention, this is in response to Examiners response on April 18, 2007 in which the examiner stated that the appellants claim language does not preclude the units from being mounted on a shopping cart that is in proximity of a display fixture. The examiner was not requiring the appellant to claim any negative limitation s but rather indicating that the claim language as written when give a broad reasonable interpretation does not "eliminate" the structure of the unit being mounted on a shopping cart which is near a display to be capable of performing the same function.

As to appellants arguments regarding "Static Positioning". As previous stated the appellant is not claiming the units in a "static" position". The appellant notes that the term "static" was used to "expound or further explain" how the claims should be interpreted in light of the specification. The examiner notes if the Appellant wishes the term "static" be interpreted in the claims the appellant must amend the claims as such. The fact that the appellant is expounding(further limiting) claim language in the arguments does not limit how the examiner interprets the actual claim language.

The appellant argues that Geigers system requires the shopping cart to move in proximity of the display not the consumer. The examiner notes that if the shopping cart is moving within proximity of the display the consumer is inherently pushing the cart within proximity and is therefore within proximity themselves. The appellant argues a scenario, which the examiner notes is how the appellant intends to use the invention and therefore holds not patentable weight, that would cause Geiger's system to not work. The examiner also gives an example, also intended use, in which Appellants system would not work. If a consumer is shopping and has their RFID card in their purse and/or cart and walks away from the cart without a the purse towards a retail display the consumer will be alerted of preferences on that display they are near because either one or both the cart and/or purse are not near the retail display to identify the consumer.

As to appellants arguments on Pg. 10 of the brief in which Appellant attempts to make a distinction between the prior art of record and the claims. The appellant argues that Geiger fails to teach an identification unit with is "Mounted stationary retail display

fixture". The examiner notes the appellant again is not claiming the identification unit as a stationary mount.

As to appellants arguments regarding "co-location" of identification units. The appellant argues that though this terminology was not used in the claim language it is how the claims are intended to be interpreted

Rejection of Dependent Claims 2, 12 and 22 as being anticipated by Geiger.

The appellant argues that Geiger fails to teach reading a magnetic card. The examiner notes that ¶ 73 teaches swiping a data card which is identified in ¶ 62 as having a magnetic strip.

Rejections of Dependent Claims 3, 5, 13, 15, 23 and 25 as being anticipated by Geiger.

As appellant argues the claims are allowable as being dependent from independent claims 1, 11 and 21 the examiner notes they are not allowable as being dependent from unpatentable independent claims.

Rejection of dependent Claims 4, 14 and 24 as being anticipated by Geiger.

Appellant argues that Geiger fails to teach preference information as "preferred price". The examiner notes that if the customer is being sent sale information because the prefer discounts vs the name brand of a product that is the preferred price. Furthermore, the examiner notes the type of preference for which information is being

sent to the user is non-functional descriptive material. Regardless of whether the consumers preference is a price, a size a name brand a color etc the steps of the method will be performed regardless of the preference use.

Rejections of dependent Claims 10, 20 and 30 as being anticipated by Geiger

The appellant argues that Geiger fails to teach illuminating a display fixture if the item is in stock. The examiner the appellant is merely claiming checking inventory for stock. The appellant is not claiming a illumination of a product display if a product is in stock.

Rejection of dependent claims 6-9, 16-19 and 26-29 as being Obvious in view of Geiger.

The appellant argues that the examiner has improperly presumed and "Electronic address" to be an email address. The examiner notes electronic email address is a broad term and can include an email address. Geiger(¶ 73) teaches sending emails with Shopping lists and promotions as well as supplying this as a user swipes a card at a Kiosk, a remote location with an electronic address.

The appellant argues that Geiger fails to teach if the direct marketing is "tradition" vs. electronic messaging. The examiner notes that if Geiger is emailing and sending information to remote kiosk, this is inherently electronic messaging. Furthermore, the act of automating, "traditional "direct marketing to electronic marketing" does not patentably distinguish the itself.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Traci L. Casler



Conferees:

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